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In re Application of :
HOFFMANN, Olaf, et al. :
U.S. Application No.: 08/913,184 : DECISION ON RENEWED
PCT No.: PCT/DE96/00457 : PETITION
International Filing Date: 05 March 1996 :
Priority Date: 07 March 1995 :
Attorney's Docket No.: 6553 US :
For: COMMUNICATIONS AND MEASUREMENT :
APPARATUS :

In a decision mailed by this Office on 20 November 2001, applicants' petition to revive was dismissed for failure to satisfy all the requirements of 37 CFR 1.137(b). Specifically, the decision found that applicant had failed to satisfy the requirement of 37 CFR 1.137(b)(3), that is, a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional."

On 12 February 2002, the USPTO received the "Renewed Petition To Revive An Unintentionally Abandoned Application Pursuant to 37 CFR 1.137(b)" considered herein. The Renewed Petition includes a certification of mailing under 37 CFR 1.8 dated 18 January 2002. Based on this certification, the Renewed Petition is considered a timely response to the 20 November 2001 decision.

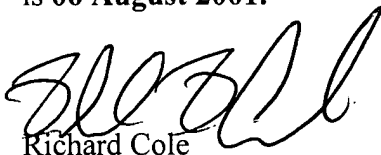
The 12 February 2002 submission includes the statement required by 37 CFR 1.137(b). Accordingly, all requirements for a grantable petition under 37 CFR 1.137(b) have now been submitted. The petition is **GRANTED**.

An additional issue argued by applicants is that the declaration received by this Office on 06 August 2001 was originally submitted as part of the "Response To Notice To File Missing Parts Of Application" filed 16 February 1999. The earlier decision noted that applicants' failure to itemize the declaration on the return postcard submitted as evidence of the earlier filing prevents the return postcard from providing evidence that the declaration was included with the 16 February 1999 submission (see MPEP section 503: "[t]he postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard."). Without the evidence of a stamped return postcard, it cannot be concluded that the declaration was included with the 16 February 1999 submission. Applicants argue here that the failure to check the declaration box on the return postcard resulted from counsel's standard practice when responding to a Notification Of Missing Requirements (attachments to such responses apparently

are not itemized), and that the USPTO should rely, not on the return postcard, but on the following: counsel's statement in the "Response To Notice To File Missing Parts Of Application" that a copy of the declaration was attached, the presence of the declaration in applicant's file copy of the 16 February 1999 Response, and the number of pages listed on the transmittal letter submitted on 16 February 1999. Applicants' arguments have been considered, but are found unconvincing. Counsel's statements in the Response are evidence only of an intent to attach the declaration to the Response; they are not evidence that the person who actually prepared and mailed the response did in fact include the declaration. The same is true of the presence of the complete submission (including declaration) in applicant's files and the number of pages on the transmittal letter. It is not uncommon for submissions to be made to the USPTO under cover letters which state that specific documents are attached, yet upon receipt, the purported attachments are found not to be present. It is for this reason that applicants are encouraged to itemize separately on return postcards all items submitted.

Accordingly, as stated in the previous decision, the declaration here is treated as having been filed on 06 August 2001. It is noted that the present application was published on 12 September 1996, making it prior art as of that date under 35 U.S.C. 102(a). Accordingly, the refusal of the USPTO to accord the application the requested 35 U.S.C. 102(e) date of 16 February 1999 does not prejudice applicants.

This application is being forwarded to the National Stage Processing Branch of the PCT Operations Division for further processing in accord with this decision. The 35 U.S.C. 371 date is **06 August 2001**.



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